

REMARKS

The Applicant thanks the Examiner for the thorough consideration given the present application. Claims 1, 2, 4, 5, 7-9, 11, 12, 14-16, and 18-22 are pending. Claims 6 and 13 are cancelled herein without prejudice to or disclaimer of the subject matter set forth therein. Claims 3, 10, and 17 were previously cancelled. Claims 1, 4, 5, 7, 8, 11, 12, 14, 15, 18, and 20-22 are amended. Claims 1, 8, 15, and 22 are independent. The Examiner is respectfully requested to reconsider the rejections in view of the amendments and remarks set forth herein.

Reasons for Entry of Amendments

At the outset, it is respectfully requested that this Amendment be entered into the Official File in view of the fact that the amendments to the claims automatically place the application in condition for allowance. As the Examiner will note, independent claims 1, 8, and 15 have been amended, respectively, to include previously examined subject matter that was previously set forth in claims 6, 13, and 20 of this application. As argued below, the Applicant respectfully submits that the subject matter previously contained in claim 6, 13, and 20 is not taught or suggested by any combination of the references cited by the Examiner. Further, the Applicant submits that the Examiner has erred in his rejection of independent claim 22. See arguments below. The Applicant submits that all claims of this application are now in condition for allowance.

In the alternative, if the Examiner does not agree that this application is in condition for allowance, it is respectfully requested that this Amendment be entered for the purpose of

appeal. This Amendment reduces the issues on appeal by placing the claims in compliance with 35 U.S.C. § 112, second paragraph, and cancels claims 6 and 13 thereby reducing the number of pending claims. This Amendment was not presented at an earlier date in view of the fact that the Examiner has just now presented new grounds for rejection in this Final Office Action.

Rejection Under 35 U.S.C. § 112, second paragraph

Claim 22 stands rejected under 35 U.S.C. § 112, second paragraph as being indefinite. This rejection is respectfully traversed.

In order to overcome this rejection, the Applicant has amended claim 22 to correct the deficiency pointed out by the Examiner. The Applicant respectfully submits that the claims, as amended, particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejections Under 35 U.S.C. §103(a)

Claims 1, 2, 4, 8, 9, 11, 15, 16, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chui et al. (U.S. 6,657,702) in view of Enomoto et al. (U.S. 5,974,401);

Claim 22 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Chui et al. in view of Enomoto et al. and Naito (U.S. 6,980,668); and

claims 5-7, 12-14, and 19-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chui et al. and Enomoto et al. and further in view of Fredlund et al. (U.S. 6,154,295).

These rejections are respectfully traversed.

Amendments to Independent Claims 1, 8, and 15

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, each of independent claims 1, 8, and 15 is amended herein to recite a novel combination of features, including *"displaying the predetermined storage period on the user terminal"*.

Support for the novel features above can be found in the specification, for example, on page 6, lines 1 to 4, page 13, lines 21-22, and page 14, line 22. Moreover, the features *"displaying the predetermined storage period on the user terminal"* were previously contained in claims 6, 7, 13, 14, 20, and 21, which were previously examined by the Examiner.

The Applicant respectfully submits that the combination of features set forth in each of independent claims 1, 8, and 15 is not disclosed or made obvious by the prior art of record, including Chui et al. and Enomoto et al. Thus, the rejection in paragraph 9 of the Office Action should be withdrawn by the Examiner.

In the rejection of claims 6, 7, 13, 14, 20, and 21 (see page 10 of the Office Action) the Examiner concedes that Chui et al. fail to disclose displaying the storage period on the user terminal. The Examiner then refers to Fredlund et al. (column 3, lines 41-57) asserting

that this document teaches displaying the storage period of the image data. The Applicant respectfully disagrees with the Examiner's conclusion. As can be seen clearly in Fredlund et al. FIG. 4, and column 3, lines 41-57, the Fredlund et al. document fails to provide any hint or suggestion of a user terminal. Column 3, lines 47-52 of Fredlund et al. merely discloses calling a 1-800 number to have a digital file deleted or extended for a certain period of time. No mention whatsoever is made in the Fredlund et al. document as to if or how the user is notified of the storage period. Thus, the rejection in paragraph 11 of the Office Action should be withdrawn by the Examiner.

In summary, at least for the reasons described above, the Applicant respectfully submits that the novel combination of features set forth in each of independent claims 1, 8, and 15 is not disclosed or made obvious by the prior art of record, including Chui et al., Enomoto et al. and Fredlund et al.

Therefore, independent claims 1, 8, and 15, and the claims depending therefrom, are in condition for allowance.

Amendments to Independent Claim 22

While not conceding the appropriateness of the Examiner's rejection, but merely to advance the prosecution of the present invention, independent claim 22 has been amended to recite a combination of features directed to a print ordering method used in a print ordering system comprising a server for receiving an order for a print of image data and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data, the print ordering method including "*determining a time of day when*

communications costs are lower than at other times of day; performing transfer of the image data from the user terminal to the server during the time of day when communications costs are lower”.

The Applicant respectfully submits that the combination of features set forth in independent claim 22 is not disclosed or made obvious by the prior art of record, including Chui et al., Enomoto et al., and Naito et al.

The Examiner concedes that Chui et al., and Enomoto et al. fail to disclose “performing transfer the image data (from the user terminal) to the server when communications cost are low(er)”, as presently claimed. The Examiner then relies on Naito et al. alleging that column 39, line 60 to column 40, line 3 discloses performing transfer of the image data to the server when communications costs are low. However, as best understood by the Applicant, Naito et al. merely discloses “a server is selected that requires the lowest cost for transmitting the image via the center server 102 to the destination server 121. Nowhere is there any hint or suggestion of *“performing transfer of the image data from the user terminal to the server during the time of day when communications costs are lower”*, as set forth in independent claim 22, as amended herein.

At least for the reasons above, the Applicant respectfully submits that the combination of features set forth in independent claim 22 is not disclosed or made obvious by the prior art of record, including Chui et al., Enomoto et al., and Naito et al.

Therefore, independent claim 22 is in condition for allowance.

All dependent claims are in condition for allowance due to their dependency from allowable independent claims, or due to the additional novel features set forth therein.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a) are respectfully requested.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone Carl T. Thomsen (Reg. No. 50,786) at (703) 208-4030 (direct line).

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

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BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #39,491
Marc S. Weiner

Registration No.: 32,181

BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorneys for Applicant

MSW/CTT/rtp/cm 